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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/605,652	10/15/2003	Jen-Shou Tseng	9269-US-PA	2651

43831 7590 09/19/2006

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EXAMINER

SEVER, ANDREW T

ART UNIT	PAPER NUMBER
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2851

DATE MAILED: 09/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/605,652	TSENG ET AL.	
	Examiner	Art Unit	
	Andrew T. Sever	2851	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 September 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-14 is/are allowed.
- 6) ☒ Claim(s) 15-30 and 32 is/are rejected.
- 7) ☒ Claim(s) 31 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 9/6/2006 has been entered.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 15-30 and 32 are rejected under 35 U.S.C. 102(b) as being anticipated by Minnesota Mining and Manufacturing company (3M), (EP 0 550 038 as cited in the previous office action.)

Claims 21-32 will be addressed first and then claims 15-20 will be addressed in order to make the rejection more clear.

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With regards to applicant's claim 21:

3M teaches in figures 1 and 2A an apparatus comprising:

Means for focusing (32) an image of a first object (transparency on stage 24) through a transparent window (40) of a scanning body, wherein said first object is positioned remote from said transparent window (40); and

Means for scanning the image (camera 30) focused through the transparent window (40) to obtain an image of the first object.

With regards to applicant's claim 22:

See for example auxiliary display (28).

With regards to applicant's claim 23:

Light source 18.

With regards to applicant's claim 24:

While not specifically set up to scan a second object, one could be placed directly under the transparent window such as shown with the hand in US 4,406,530 to Hasegawa et al. figure 1b which is place in a different location then the typical place for a transparency.

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With regards to applicant's claim 25:

Vertical and horizontal are relative orientation, one of ordinary skill in the art would recognize that any object could be rotated 90 degrees relative to the other and both placed under part 14 of the 3M reference one would be first object and the other the second.

With regards to applicant's claim 26:

Part 42 is a projection means.

With regards to applicant's claims 27-30 and 32:

See above.

With regards to applicant's claim 15:

When using the above apparatus, an object is placed on the glass sheet forming stage (24 as is the typical means for operating a over head projector see column 3 and 4 of the 3M reference), lens 32 focuses an image of the transparency through transparent window to scanner (34) and an electronic image of the object is produced.

With regards to applicant's claim 16:

As shown in figure 1 the output of the projector can be linked with other electronic devices including storage devices.

With regards to applicant's claim 17:

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Part 18 is an illumination device (light source).

With regards to applicant's claim 18-20:

See above with regards to claims 24-26.

Allowable Subject Matter

4. Claims 1-14 are allowed.
5. Claim 31 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
6. The following is a statement of reasons for the indication of allowable subject matter:

Independent claims 1 and 7 have been amended to include the limitation that the lens focuses an image of the object that is located remote from the transparent window onto the scanner. Further claims 1 and 7 require the scanning module reciprocally moves underneath the transparent window. The lens of Fujioka is not specified to be able to focus an object remote from the transparent window onto the scanner. The scanner of the 3M reference does not reciprocally move and it would not be obvious to combine them.

No other prior art was found that alone or in combination taught all of the claimed limitations, accordingly claims 1 and 7 are allowable and claims 2-6 and 8-14 are allowable due to their dependency on claims 1 and 7 respectively.

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With regards to claim 31, it claims that the object is a blackboard; the apparatus of the 3M reference would not be able obtain a focused image of a black board placed underneath it; nor is it entirely clear how one would place one in the appropriate position accordingly claim 31 would be allowable if re-written in independent form including all the limitations of claim 27.

Response to Arguments

7. Applicant's arguments with respect to claims 15-30 and 32 have been considered but are moot in view of the new ground(s) of rejection.

Claims 15-30 and 32 are rejected under new grounds of rejection and accordingly applicant's arguments are moot. With regards to applicant's claims 1-14 and 31. They have been indicated as being allowable due to applicant's amended claim language.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew T. Sever whose telephone number is 571-272-2128. The examiner can normally be reached on 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diane Lee can be reached on (571) 272-2399. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AS



Andrew Seever